

RemarksRejections Under 35 U.S.C. § 112

The Examiner has rejected claims 1-12 and 15-16 under 35 U.S.C. § 112, second paragraph as indefinite. The Applicants respectfully request the Examiner's careful consideration of the explanations provided below regarding the rejections of these claims.

Rejections of claims 1-7 and 15 Under 35 U.S.C. § 112

Claim 1 includes the limitations of ***"If a determination has not been made*** that a set of the captured data is the same as any set of the stored data based upon the probability calculation, further determining whether any captured data sets and stored data sets having the same first attribute have the same second and third data attributes". (emphasis added) The Applicants respectfully disagree with the Examiner's contention that these limitations render claim 1 indefinite.

As the Applicants know that the Examiner is well aware from MPEP 2173.02, "The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available." Furthermore, MPEP 2173.02 states, "The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity" and "In reviewing a claim for compliance with 35 U.S.C. § 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. § 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent." The Applicants' representative could not locate, in the MPEP, a per se requirement that the "condition word "if" renders the claims indefinite". If such a per se requirement

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exists, the Applicants respectfully request that the Examiner identify the section of the MPEP reciting the per se requirement.

The section of claim 1 recited above recites a condition under which the act of "further determining whether any captured data sets and stored data sets having the same first attribute have the same second and third data attributes" is performed. The condition under which the act will be performed is "if a determination has not been made that a set of the captured data is the same as any set of the stored data based upon the probability calculation". Thus it is definite when this act will be performed. The Applicants respectfully submit that claim 1 meets the "threshold requirements of clarity and precision", and is therefore not indefinite, because claim 1 "set[s] out and circumscribe[s] a particular subject matter with a reasonable degree of clarity and particularity" as stated in this cited section of the MPEP. Accordingly, the Applicants respectfully request withdrawal of the rejection of claim 1 under 35 U.S.C. § 112, second paragraph.

Claims 2-7 and 15 are dependent, either directly or indirectly, upon claim 1 and therefore incorporate all the limitations of claim 1. For at least the reason that claim 1 is not indefinite, claims 2-7 and 15 are not indefinite. Accordingly, the Applicants respectfully request withdrawal of the rejections of claim 2-7 and 15 under 35 U.S.C. § 112, second paragraph.

Rejections of claims 8-12 and 16 Under 35 U.S.C. § 112

Claim 8 includes the limitations of "logic for further determining whether captured image data sets and stored image data sets having the same size attribute also have at least two other data attributes that are the same *if a determination has not been made that a set of the captured image data is the same as any set of the stored image data based upon the probability calculation*, wherein the probability calculation is updated based upon the determination involving the at least two other data attributes". (emphasis added) On a similar basis as the explanation provided with respect to the 35 U.S.C. § 112, second paragraph rejections of claim 1, the Applicants respectfully contend

that claim 8 is not indefinite under 35 U.S.C. § 112, second paragraph. Accordingly, the Applicants respectfully request withdrawal of the rejection of claim 8 under 35 U.S.C. § 112, second paragraph.

Claims 9-12 and 16 are dependent, either directly or indirectly, upon claim 8 and therefore incorporate all the limitations of claim 8. For at least the reason that claim 8 is not indefinite, claims 9-12 and 16 are not indefinite. Accordingly, the Applicants respectfully request withdrawal of the rejections of claim 9-12 and 16 under 35 U.S.C. § 112, second paragraph.

Rejections Under 35 U.S.C. § 101

The Examiner has rejected claims 8-12 and 16 under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Applicants respectfully request the Examiner's careful consideration of the explanations provided below regarding the rejections of these claims.

Rejection of Claims 8-12 and 16 Under 35 U.S.C. § 101

The Examiner has rejected claim 8 as directed to non-statutory subject matter because, as explained in item 9 on page 4 of the office action mailed on March 24, 2006, "The Specification of the current application, such as on Page 7, Lines 9-13 claims a medium of "paper" which is non-statutory. Printing text of code on a paper, whether it can be scanned by a computer or not is directed towards copyright material and not towards Patentable subject matter." The Applicants respectfully disagree that claim 8 is directed to non-statutory subject matter. As the Applicants know that the Examiner is well aware, according to MPEP 2106(IV)(B)(1), "Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." ***In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component***" (emphasis added) and "Both types of "descriptive material" are nonstatutory claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. ***When functional descriptive material is***

recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. (emphasis added)

Page 7, lines 9-13 of the originally filed application state that "The computer readable medium could even be paper or another suitable medium upon which the program is printed, as the program can be electronically captured, for instance via optical sensing or scanning of the paper, and then compiled, interpreted or otherwise processed in a suitable manner before being stored in a the memory 130". The Applicants respectfully submit that the embodiment of computer readable medium described in the detailed description does correspond to statutory subject matter according to MPEP 2106(IV)(B)(1). First, the embodiment of computer readable medium described in the detailed description does correspond to statutory subject matter because this embodiment of the subject matter of claim 8 falls within the definition of "functional descriptive material". That is, this particular disclosed embodiment of the "computer readable medium" of claim 8 does correspond to "data structures and computer programs which impart functionality when employed as a computer component" because as indicated above in the cited sections of the detailed description, "the program can be electronically captured, for instance via optical sensing or scanning of the paper, and then compiled . . .". And second, this particular embodiment of the "computer readable medium" of claim 8 is such that the "functional descriptive material" "becomes structurally and functionally interrelated to the medium" because when the program is printed on paper such that it is capable of electronic capture it becomes structurally and functionally interrelated to the paper. Therefore, this particular embodiment of the "computer readable medium" of claim 8 does correspond to statutory subject. Accordingly, the Applicants respectfully request withdrawal of the rejection of claim 8 under 35 U.S.C. § 101. Furthermore, for at least the reason that claims 9-12 and 16 are dependent upon claim 8 which is directed to statutory subject matter under 35 U.S.C. § 101, the Applicants respectfully submit that claims 9-12 and 16 are

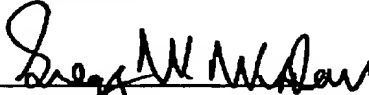
directed to statutory subject matter under 35 U.S.C. § 101. Accordingly, the Applicants respectfully request withdrawal of the rejection of claims 9-12 and 16 under 35 U.S.C. § 101.

Conclusion

The Applicants respectfully submit that the subject application is in a condition for allowance. Allowance is respectfully requested.

Respectfully submitted,

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